

REMARKS

A. INTRODUCTION

Claims 139-300 are pending and rejected.

Upon entry of this Amendment:

- Claims 291-316 will be pending
- Claims 301-316 will be added
- Claims 139-290 will be cancelled without prejudice
- Claims 291, 295, and 300 will be the only independent claims
- The Specification will be amended to correct minor and obvious typographical errors. No new matter will be added.

B. REQUEST FOR CONTINUED EXAMINATION

This paper is being filed in response to an Office Action mailed October 19, 2006. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

C. SECTION 103(A) REJECTIONS

All of the rejected claims (Claims 139-300) stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier (U.S. Patent No. 5871398) and further in view of Sullivan (U.S. Patent No. 6663105).

We respectfully traverse the Examiner's Section 103(a) rejections.

However, Claims 139-290 have been cancelled without prejudice by this Amendment, so their rejection is moot. We intend to pursue the subject matter of the cancelled claims in one or more continuing applications, and will address any prior rejections as necessary in those applications.

1. The Cited References: Schneier and Sullivan

The Examiner asserts: "Schneier does not explicitly disclose that the validation code/message can be given as an reward for a user qualifying action such as a purchase." [Office Action, page 14]. This is the only statement as to what Schneier does not teach.

Accordingly, as indicated in our previous Response, we have assumed that the Examiner is relying only on Schneier as teaching all other recited subject matter. The Examiner has not responded at all to our attempts to clarify this, so we proceed based on our assumption.

2. Independent Claim 291

291. (PREVIOUSLY PRESENTED) A method comprising:
generating a plurality of locked outcomes;
generating, for each of the plurality of locked outcomes, a
respective unlock code capable of unlocking the locked outcome;
transmitting at least one of the plurality of locked outcomes to a
device of a user;
transmitting at least one of the plurality of unlock codes to a
merchant,
in which the user is not the same as the merchant; and
receiving, from the user, an indication of at least one of the at least
one unlock codes transmitted to the merchant.

Claims 291 does not recite in which a qualifying action as a “reward for a user qualifying action such as a purchase.” Accordingly, the Examiner must not be relying on Sullivan at all in rejecting Claim 291.

Consequently, we are now confused as to the statutory basis on which Claim 291 is rejected. Did the Examiner intend to reject Claim 291 as anticipated by Schneier? This appears to be the case.

Or does the Examiner believe that Schneier does not teach or suggest the entire recited method of Claim 291? If so, the Examiner does not indicate how Schneier is deficient, and has not complied with the Graham requirements for an obviousness rejection (i.e., the Examiner has not ascertained “the differences between the prior art and the claims at issue”), much less explained how any such differences would be obvious, based on evidence of record. We note again that Sullivan is only relied upon for subject matter that is not explicitly recited in Claim 291.

If the Examiner does believe that Schneier is somehow deficient, the Examiner must indicate the differences, and identify (1) evidence of record that teaches the differences, and (2) evidence of record that modification of Schneier to provide for all of the recited subject matter would have been obvious. As the Examiner has failed to frame the statutory basis improperly, or, alternatively, because the Examiner has failed to ascertain the differences between Claim 291 and Schneier, the Examiner has not provided a prima facie case of anticipation or obviousness for Claim 291. We respectfully request reconsideration and clarification of any rejection of Claim 291.

We proceed on the assumption that the Examiner is relying only upon Schneier. It is not clear to us how the Examiner is arguing that Schneier teaches a

method including all of the recited steps. For instance, the Examiner asserts that Schneier discloses “the utilization of retailers,” but does not explain how Schneier suggests the specific combination of transmitting at least one of the plurality of locked outcomes to a device of a user and also transmitting at least one of the plurality of unlock codes to a merchant, in which the user is not the same as the merchant. The Office Action is not clear, and we request that the Examiner explain how Schneier teaches a method including this particular combination of steps, or if the Examiner concedes that Schneier does not teach such a combination of steps, we request that clarify this for the record.

Implicit in Claim 291 is that the user must have somehow acquired the unlock code that prior was transmitted to the merchant. We do not believe Schneier or Sullivan, alone or in combination, suggests this particular combination of features

The Examiner asserts: “Schneier further discloses that the merchant can buy tickets.” [Office Action, page 12]. In the cited passage, the lottery retailer clearly buys the paper tickets, which, as discussed above, include both the unrevealed outcomes and the unrevealed validation numbers. . Schneier does describe how prior art paper ticket systems utilize “validation numbers.” Schneier also describes a system in which a handheld ticket viewer (a device) may be used to provide lottery outcomes for a player. But Schneier does not appear to suggest that the validation numbers under latex on the paper tickets have anything to do with the outcomes used with the handheld ticket viewer. The Examiner does not explicitly state otherwise. As mentioned in our previous Response, there is no suggestion in any of the cited references of bifurcating the distribution of locked outcomes and unlock codes. To the contrary, the prior art paper ticket system suggests that an outcome and its validation number are always embodied integrally under latex in a paper ticket. The Examiner has not addressed this argument, and does not explain how Schneier suggests such subject matter. If the player can reveal the outcome without the “validation number” (e.g., by scratching off a paper ticket), then outcome concealed under the latex on the paper ticket is not locked, and thus the validation number is not an unlock code. There is no suggestion of an entity transmitting locked outcomes to a device of a user and also transmitting unlock codes to a merchant, and also receiving from a user an indication of an unlock code transmitted to a merchant. The Examiner has not addressed this argument.

Neither Schneier nor Sullivan, alone or in combination, appear to suggest the entire method of Claim 291. The Examiner has failed to establish a prima facie case of anticipation or obviousness for at least this reason. Although one of ordinary skill in the art may have known of a motivation not specifically indicated

in any specific reference but that could be drawn reasonably from what was generally known, as explained in In re Bozek (cited by the Examiner), the Examiner must provide some objective source of evidence in support of any such general knowledge. 416 F.2d 1385, 1390 (“Having established that this knowledge was in the art [by citation of a specific publication], the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”) (emphasis added). The Examiner has not provided any evidence of any motivation to modify Schneier to provide for all of the subject matter of Claim 291. We respectfully request the Examiner reconsider and allow Claim 291.

If the Examiner in fact intended to provide an obviousness rejection, the Examiner, as noted above, has still not articulated any differences between Claim 291 and the asserted prior art. Regardless, of record, the asserted motivations to modify Schneier are still only:

...it would have been obvious...to add Sullivan’s validation codes for prizes as an incentive for purchases to Schneier’s validation codes and retailer/vendor stores and variety of incentives. One would have been motivated to do this in order to better promote store activity.

Also it would have been obvious...that a variety of activities of retailer/vendor interest can be promoted. One would have been motivated to do this in order to better promote activities of benefit to retailer/vendors.

[Office Action, page 15].

We respectfully submit that these conclusory motivations do not seem to be supported by the references and, regardless, would not have suggested the desirability of modifying Schneier to provide for all of the features of any of the rejected claims. The Examiner’s asserted motivations do not suggest any specific combination of features. Recognition of a general motivation (e.g., “better promote activities of benefit to retailer/vendors”; “to better promote store activity”) does not necessarily suggest a particular solution to the problem. “Recognition of an unsolved problem does not render the solution obvious.” Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 381 F.3d 1371, 1377, 72 U.S.P.Q.2D 1333, 1337 (Fed. Cir. 2004) (“Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure.”).

The Examiner has failed to establish a prima facie case of rejection of Claim 291 under Section 102 or Section 103(a) for at least the reasons stated above.

3. Independent Claim 291

295. (PREVIOUSLY PRESENTED) A method comprising:
purchasing a plurality of unlock codes, each unlock code being associated with an identifier that identifies a respective lottery outcome;
determining that a user has satisfied a qualifying action that is associated with a retailer;
receiving, by a device of the retailer from a device of a user, an identifier that identifies a lottery outcome that is locked;
determining an unlock code of the plurality of purchased unlock codes based on the received identifier that identifies the lottery outcome that is locked; and
providing the determined unlock code to the user.

We respectfully submit that the Examiner has not established a prima facie case of obviousness for Claim 295. The rejection of Claim 295 is deficient for many of the same reasons stated above with respect to Claim 291. For example, nothing in Claim 295 recites a qualifying action, so the Examiner must not be relying upon Sullivan, and the Examiner may have intended to provide an anticipation rejection. As the record is fatally unclear as to the actual basis of rejection, the rejection must be withdrawn.

Also, as explained in our previous Response, the Examiner does not explain how Schneier or Sullivan, alone or in combination, would suggest an entity that would purchase a plurality of unlock codes and would provide an unlock code to a user after receiving from a device of user an identifier that identifies a lottery outcome that is locked. Schneier does not appear to suggest that a retailer provides either a paper “validation number” or an electronic unlock code to a device of a user after receiving from the user an indication of a lottery outcome that is locked. The Examiner has not responded to this argument, but again simply states that Schneier discloses “the utilization of retailers” and “the merchant can buys [sic] tickets.” The Examiner has failed to provide a prima facie case of rejection of Claim 295 on any statutory basis for at least the reasons stated above.

4. Independent Claim 300

300. (PREVIOUSLY PRESENTED) A method comprising:
generating an outcome;
generating an unlock code capable of unlocking said outcome;

providing an indication of said outcome to at least one user device;
receiving payment for said indication of said unlock code;
providing an indication of said unlock code to an intermediary device in exchange for the payment; and
providing an indication of a benefit associated with said outcome.

We respectfully submit that the Examiner has not established a prima facie case of obviousness for Claim 300. The rejection of Claim 300 is deficient for many of the same reasons stated above with respect to Claim 291. For example, nothing in Claim 300 recites a qualifying action, so the Examiner must not be relying upon Sullivan, and the Examiner may have intended to provide an anticipation rejection. As the record is fatally unclear as to the actual basis of rejection, the rejection must be withdrawn.

Also, as explained above with respect to Claims 291 and 295, the Examiner does not explain how Schneier or Sullivan, alone or in combination, would suggest an entity that would provide for a combination of steps including providing an indication of an outcome to a user device, exchanging an unlock code for said outcome for payment, and providing an indication of the purchased unlock codes to an intermediary device, at least because the cited references do not appear to suggest any bifurcated providing of unlock codes and outcomes to intermediaries and users, respectively. The Examiner has failed to provide a prima facie case of rejection of Claim 300 on any statutory basis for at least the reasons stated above.

D. NEW CLAIMS 301-316

New Claims 301-316 all depend from one of the independent claims and are believed to contain allowable subject matter for at least the reasons stated above with respect to claims 291, 295, or 300.

Further, each of the dependent claims recites additional subject matter that is not taught or suggested by any combination of Schneier and Sullivan, and that is fully supported by the Specification. No new matter has been added.

E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a one-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

Charge: \$120.00

Deposit Account: 50-0271

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Please charge any appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to Deposit Account 50-0271. Please credit any overpayment to the same account.

F. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's reconsideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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